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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,905	12/09/2003	Dirk Sembritzki	4002-1024-1	3310

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,905	Applicant(s) SEMBRITZKI ET AL.	
	Examiner Catherine Simone	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/19/2007 has been entered.

Withdrawn Rejections

2. The 35 U.S.C. 112, first paragraph, rejection of claim 19 of record in the Final Office Action mailed 3/19/2007, Pages 4-5, Paragraph #7 has been withdrawn due to the Applicant's amendment filed 7/19/2007.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz (EP 0 344 056).

Regarding claims 12-14 and 18, Schulz teaches a laminated tissue paper comprising at least two tissue plies with substantially identical embossing patterns, the embossing patterns consisting of embossing protrusions, wherein the at least two plies are displaced relatively to each other in a displacement direction, and laminated with the protrusions of the plies extending in the same direction (*see col. 3, lines 20-45*), such that the laminated tissue paper has a greater bulk than when the at least two plies are not displaced relatively to each other in the displacement direction (*col. 2, lines 49-50 and see claim 7*).

However, Schulz fails to specifically teach a maximum distance D in the displacement direction between an embossing protrusion of a first ply and an embossing protrusion of a second ply, which is displaced relative to the first one, being set as a function of the height H of the embossing protrusions and the length L of the embossing protrusions in the displacement direction so that D is equal to the smaller one of the values of $12H$ and $14L$, $8H$ and $10L$, and $6H$ and $8L$.

The optimum ranges for the maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the two tissue plies in Schulz to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply, which is displaced relative to the first one, set as a function of the height H of the embossing protrusions and the length L of the embossing protrusions in the displacement direction so that D is equal to the smaller one of the

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values of 12H and 14L, 8H and 10L, and 6H and 8L, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Regarding claim 15, note at least one further tissue ply, which is superimposed to the laminated tissue paper (*see col. 4, lines 14-23 and line 63*). Regarding claim 16, note at least one further tissue ply is another laminated tissue paper (*see col. 4, lines 14-23 and line 63*). Regarding claim 17, note the plies are laminated by mechanical ply bonding (*see col. 3, lines 46-48*).

Regarding claim 19, Schulz teaches a laminated tissue paper comprising a first tissue ply and a second tissue ply wherein the first and second plies have substantially identical embossing patterns, the embossing patterns consist of embossing protrusions (embossments), each protrusion having a height and length, the first ply and the second ply are displaced relatively to each other in a displacement direction, and laminated with the protrusions of the plies extending in the same direction (*see col. 3, lines 20-45 and see claim 7*) and the laminated tissue paper has a greater softness and a greater bulk (*col. 2, lines 49-50 and claim 7*) than when the first ply and the second ply are not displaced relatively to each other in a displacement direction.

However, Schulz fails to specifically teach a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply being equal to the smaller one of the values of 12H and 14L.

The maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply would be readily

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determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the two tissue plies in Schulz to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply equal to the smaller one of the values of 12H and 14L, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Response to Arguments

5. Applicant's arguments filed 7/19/2007 have been fully considered but they are not persuasive.

Applicants argue "Schulz discloses that the re-joined two-ply tissue has a caliper, or thickness, essentially the same as embossed two-ply tissue without the separation and rejoining steps (column 3, lines 50-65). This is not the same as the claimed invention".

However, it is to be pointed out that Schulz discloses that the re-joined two-ply tissue has a caliper, or thickness, *essentially* the same as, not *exactly* the same as, embossed two-ply tissue without the separation and recombining steps (col. 3, lines 59-65), which implies that the thickness of the re-joined two-ply tissue did change, even if it may be a slight change. Therefore, the two-ply tissue paper in Schulz is deemed to have some change in thickness in the end result.

Applicants state that "the difference between the claimed invention and Schulz may be illustrated by Figures 6 A and 6B of the present specification...Figure 6A illustrates the

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thickness of a two-ply paper that is embossed two-ply tissue without separation and displacement of the plies of the claimed invention, i.e., the thickness desired by Schulz. Figure 6B illustrates the thickness of the claimed invention. As evidenced by these Figures, the teachings of Schulz are contrary to the claimed invention". Applicants then argue "one of ordinary skill in the art would have been discouraged from selecting the recited maximum distance D of the embossing patterns in the displacement direction that is equal to the smaller one of the values of 12H and 14L of claim 12, as the resulting tissue paper would not have the desired bulk of Schulz, i.e., essentially the same as two plies embossed together".

First, it is to be pointed out that the two-ply tissue paper taught in Schulz is made by a process (col. 3, lines 20-49) that is similar to the process of making the two-ply tissue paper disclosed in Applicant's present invention, i.e. embossing, separating, displacing and recombining. Second, the two plies of tissue paper in Schulz are being displaced relative to one another by an amount sufficient to prevent nesting of the embossments (col. 3, lines 33-36 and claim 7), which is also similar to that of the tissue paper disclosed in Applicant's present invention. Third, Schulz teaches the end result of the two-ply tissue paper having an enhanced bulk and softness (col. 2, lines 49-50 and claim 7), which is similar to the tissue paper disclosed in Applicant's present invention.

For these reasons listed above, the Examiner believes the two-ply tissue paper taught in Schulz inherently has an increase in thickness in the end result. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the two tissue plies in Schulz to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply

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equal to the smaller one of the values of 12H and 14L, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Additionally, it is to be pointed out that the arguments of counsel cannot take the place of evidence in the record (see *MPEP 2145 (I)*).

Furthermore, Applicants argue "Schulz fails to recognize the benefits of selecting the recited D value and increased bulk/thickness of the claimed invention... This benefit cannot be achieved by Schulz, as Schulz requires that the thickness of the paper be the same as a conventional embossed sheet, i.e., one that is not separated and rejoined".

However, as pointed out above, it is believed that the two-ply tissue paper in Schulz inherently has some increase in thickness and therefore, the benefits of the claimed invention can be achieved by Schulz. Again, it is to be pointed out that the arguments of counsel cannot take the place of evidence in the record (see *MPEP 2145 (I)*).

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone, whose telephone number is (571) 272-1501. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine A. Simone/
Catherine A. Simone
Examiner
Art Unit 1772
August 19, 2007


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